

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor:	Lee, Yeong-Chun	
Serial No:	10/533,802	Group Art Unit: 3753
Filing Date:	5/4/2005	Examiner: Fox, John C.
Title:	WALL WATER PANEL	BRIEF ON APPEAL

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
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BRIEF ON APPEAL

This Brief supports the appeal to the Board of Patent Appeals and Interferences from the Final Rejection dated November 13, 2009, in the above-captioned application. Appellant filed a Notice of Appeal on January 18, 2010, and now submits this Brief in compliance with 37 C.F.R. § 1.192.

Pursuant to 37 C.F.R. § 1.192, the two-month period for filing an Appeal Brief tolls from the date of filing the Notice of Appeal, *i.e.*, January 18, 2010. This Appeal Brief is timely filed within the two-month period, which extends until March 18, 2010.

1. REAL PARTY IN INTEREST

The real party in interest is PIP Co., Ltd., a Limited Liability Company organized under the laws of the Republic Of Korea, having a place of business at Sangmun Plaza, 6th Floor, 1061-1 Jung-Dong, Wonmi-Gu, Bucheon-Si, 420-02. An assignment of the inventor's entire right, title and interest is recorded in the USPTO at Reel 019443 Frame 0460. Therefore, the real party in interest is PIP Co., Ltd.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant or Appellant's legal representative, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS

Claims 5-11 are pending in the application. Claims 5-11 stand finally rejected.

The pending claims that are the subject of this Appeal are set forth in the attached Claims Appendix.

4. STATUS OF AMENDMENTS

No Amendments were filed after the Final Rejection.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention provides a wall-concealed water service box, comprising a case that has a built-in flexible hose connecting a soft tube with a water tap and a valve plate. Referring to Figures 1 and 2 of Appellant's specification, the water service box (1) comprises a case (2) having a built-in flexible hose (9) connecting a soft tube (34) with a water tap (33) and a valve plate (12). Specification at paragraph [0018], Figs. 1 and 2. The soft tube (34) is a hot or cold water pipe guided from the outside. Specification at paragraph [0032]. It may be verified in the figures that the water service box (1) comprises a case (2) that has a built-in flexible hose (9) and a valve plate (12) that opens and closes. Specification at paragraph [0020], Figs. 1 and 2. That is, valve plate (12) is a means to close or open the case (2). Specification at paragraph [0024]. The invention thus provides a unified, wall-concealed water service box, having a built-in flexible hose for connecting soft hot and/or cold water pipes and the water tap, so as to allow the service box to be opened and closed, without disturbing the pipe connections, thereby unifying, rather than merely housing the connections. Further, with its built-in tubing, the water service box of the invention can easily be assembled and disassembled, and its internal situation can be checked directly by placing a hand through its maintenance hole, so that it will be easy to determine the situation, to retrofit and maintain, and be effective to finish the work neatly with an access plate. Specification at paragraph [0016].

6. **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claims 5-11 stand finally rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
2. Claims 5-11 stand finally rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.
3. Claims 5-11 stand finally rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which the applicant regards as the invention.

7. **ARGUMENTS**

Appellant respectfully disagrees with the rejections, and believes that claims 5-11 are patentable and in full compliance with 35 U.S.C. § 112, first and second paragraphs.

The Examiner maintains that there is no written description and no enabling disclosure of a "built-in" flexible hose connecting a soft tube with a water tap. As such, the Examiner maintains that the claims are indefinite, since the written description and enablement requirements are not met.

Appellant respectfully disagrees with the rejections and respectfully requests that this Board reverse the final rejections of claims 5-11.

(7.1)

**Appellant had Possession of a "Built-in" Flexible Hose
Connecting a Soft Tube With a Water Tap**

Section 112 of the patent statute describes what must be contained in the patent specification. Among other things, it must contain "a written description of the invention, and of the manner and process of making and using it . . . [such] as to enable any person of ordinary skill in the art to which it pertains . . . to make and use the same . . ." 35 U.S.C. § 112 ¶ 1. Thus, this statutory language mandates satisfaction of two separate and independent requirements: an applicant must both describe the claimed invention adequately and enable its reproduction and use. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

The purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is

therefore required to "recount his invention in such detail that his future claims can be determined to be encompassed within his original creation." *Id.* at 1561, 19 USPQ2d at 1115. Satisfaction of this requirement is measured by the understanding of the ordinarily skilled artisan. *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) ("The description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). "Compliance with the written description requirement is essentially a fact-based inquiry that will 'necessarily vary depending on the nature of the invention claimed.'" *Enzo Biochem v. Gen-Probe, Inc.*, 296 F.3d 1316, 1324, 63 USPQ2d 1609, 1613 (Fed. Cir. 2002). Because of its fact intensive nature, the Federal Circuit reviews a lower tribunal's decision on the adequacy of written description for clear error. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000).

The test for compliance with the written description requirement is whether the disclosure as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The standard is whether the written description allows persons of ordinary skill in the art to recognize that the patent applicant invented what is claimed. *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

Applicant's independent claim 5 recites a wall-concealed water service box, comprising a case that has a built-in flexible hose connecting a soft tube with a water tap and a valve plate. Referring to Figures 1 and 2 of Applicant's specification, the water service box (1) comprises a case (2) having a built-in (i.e., integral) flexible hose (9) connecting a soft tube (34) with a water tap (33) and a valve plate (12). Specification at paragraph [0018], Figs. 1 and 2. The soft tube (34) is a hot or cold water pipe guided from the outside. Specification at paragraph [0032]. It may be verified in the figures that the water service box (1) comprises a case (2) that has a built-in (i.e., integral) flexible hose (9) and a valve plate (12) that opens and closes. Specification at paragraph [0020], Figs. 1 and 2. That is, valve plate (12) is a means to close or open the case (2). Specification at paragraph [0024]. The invention thus provides a unified, wall-concealed water service box, having a built-in flexible hose for connecting soft hot and/or cold

water pipes and the water tap, so as to allow the service box to be opened and closed, without disturbing the pipe connections, thereby unifying, rather than merely housing the connections. Further, with its built-in tubing, the water service box of the invention can be easily assembled and disassembled, and its internal situation can be checked directly by placing a hand through its maintenance hole, so that it will be easy to determine the situation, to retrofit and maintain, and be effective to finish the work neatly with an access plate. Specification at paragraph [0016].

Applicant's specification clearly states that the case has a built-in flexible hose connecting a soft tube with a water tap and a valve plate. The built-in nature of the flexible hose is clearly described as such at numerous points in Applicant's specification, including, for example, at paragraphs [0007], [0008], [0015], [0016], [0018], [0020], [0046] and [0049]. Therefore, the disclosure reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.

For the foregoing reasons, Appellant respectfully requests that this Board reverse the rejection of claims 5-11 as failing to comply with the written description requirement.

(7.2)

**The Specification Enables Those of Ordinary Skill to
Make and Use the Claimed Apparatus, Without Undue
Experimentation**

The test for enablement is whether the disclosure, when originally filed, contained sufficient information regarding the subject matter of the claims as to enable those of ordinary skill in the pertinent art to make and use the invention. The standard is whether the experimentation necessary to practice the invention is undue or unreasonable. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). See also U.S. v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.")

Applicant's independent claim 5 recites a wall-concealed water service box, comprising a case that has a built-in flexible hose connecting a soft tube with a water tap and a valve plate. Referring to Figures 1 and 2 of Applicant's specification, the water

service box (1) comprises a case (2) having a built-in (i.e., integral) flexible hose (9) connecting a soft tube (34) with a water tap (33) and a valve plate (12). Specification at paragraph [0018], Figs. 1 and 2. The soft tube (34) is a hot or cold water pipe guided from the outside. Specification at paragraph [0032]. It may be verified in the figures that the water service box (1) comprises a case (2) that has a built-in (i.e., integral) flexible hose (9) and a valve plate (12) that opens and closes. Specification at paragraph [0020], Figs. 1 and 2. That is, valve plate (12) is a means to close or open the case (2). Specification at paragraph [0024]. The invention thus provides a unified, wall-concealed water service box, having a built-in flexible hose for connecting soft hot and/or cold water pipes and the water tap, so as to allow the service box to be opened and closed, without disturbing the pipe connections, thereby unifying, rather than merely housing the connections. Further, with its built-in tubing, the water service box of the invention can be easily assembled and disassembled, and its internal situation can be checked directly by placing a hand through its maintenance hole, so that it will be easy to determine the situation, to retrofit and maintain, and be effective to finish the work neatly with an access plate. Specification at paragraph [0016].

As noted above, Applicant's specification clearly states that the case has a built-in flexible hose connecting a soft tube with a water tap and a valve plate. The built-in nature of the flexible hose is clearly described as such at numerous points in Applicant's specification, including, for example, at paragraphs [0007], [0008], [0015], [0016], [0018], [0020], [0046] and [0049]. Therefore, the disclosure contains sufficient information regarding the subject matter of the claims to enable those of ordinary skill in the pertinent art to make and use the invention.

For the foregoing reasons, Appellant respectfully requests that this Board reverse the rejection of claims 5-11 as failing to comply with the enablement requirement.

(7.3)
The Claims Particularly Point Out and Distinctly Claim
the Subject Matter, Which Appellant Regards as the
Invention

The requirement that a claim must particularly point out and distinctly claim the metes and bounds of the subject matter that will be protected by the patent grant is an objective one because it is not dependent on the views of any particular individual, but

rather is evaluated in the context of whether the claim is definite. The test for claim definiteness is whether the scope of the claim is clear and unambiguous to a hypothetical person possessing the ordinary level of skill in the pertinent art. The claims are to be read in light of the prior art and the specification rather than in a vacuum. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The scope of claim 5 is clear and unambiguous to one of ordinary skill in the art. More particularly, Applicant's specification clearly shows that the case has a built-in flexible hose connecting a soft tube with a water tap and a valve plate. The built-in nature of the flexible hose is clearly described as such at numerous points in Applicant's specification, including, for example, at paragraphs [0007], [0008], [0015], [0016], [0018], [0020], [0046] and [0049]. Therefore, the scope of the claims is clear and unambiguous and a hypothetical person possessing the ordinary level of skill in the pertinent art would understand what is meant by a "built-in" flexible hose connecting a soft tube with a water tap.

For the foregoing reasons, Appellant respectfully requests that this Board reverse the rejection of claims 5-11 as being indefinite.

8. CONCLUSION

In conclusion, Appellant respectfully requests that this Board reverse each of the grounds of rejection maintained by the Examiner.

Respectfully submitted,

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(A1)
CLAIMS APPENDIX
Claims on Appeal

1. (Cancelled)
2. (Cancelled)
3. (Cancelled)
4. (Cancelled)
5. (Previously presented) A wall-concealed water service box, comprising a case that has a built-in flexible hose connecting a soft tube with a water tap and a valve plate.
6. (Previously presented) The apparatus of claim 5, wherein one end of said flexible hose connects and fastens with said soft tube protected by a corrugated tube through a reducing socket, and the other end of said flexible hose connects and fastens with said water tap.
7. (Previously presented) The apparatus of claim 6, further comprising a friction projection and a maintenance hole formed on said valve plate.
8. (Previously presented) The apparatus of claim 7, further comprising a rim member around the maintenance hole and an access plate for opening and closing said case.
9. (Previously presented) The apparatus of claim 8, wherein said reducing socket at which the connection tube of said water outlet is inserted and fixed is fastened and fixed with said access plate through a socket insertion hole.
10. (Previously presented) The apparatus of claim 9, wherein a latch is formed on a part of said access plate and also fastened with said flexible hose to become one body.
11. (Previously presented) The apparatus of claim 10, wherein said flexible hose is furnished with coil springs inside or outside of stainless threads.

(A2)

EVIDENCE APPENDIX

Copies of any evidence entered and relied upon in the appeal.

NONE

(A3)

RELATED PROCEEDINGS APPENDIX

Copies of decisions rendered by a court or the Board in any proceeding identified in the related appeals and interferences section.

NONE